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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 *Ex parte* TATSUO EGUCHI, YASUHIKO TERASHITA,
11 YASUO NOMURA, YASUSHI MIYAJIMA, YOSHIKAZU WATANABE,
12 NOBUAKI YAMAGUCHI, KUMIKO SASAKI, MAKOTO NIJIMA,
13 AI SUZUKI, SHINYA FUJII, and YUSUKE TANI
14

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16 Appeal No. 2010-006340
17 Application No. 09/720,537
18 Technology Center 2400
19

20
21 Oral Hearing Held: January 10, 2012
22
23

24 Before ALLEN R. MACDONALD, ROBERT E. NAPPI, and
25 ELENI MANTIS-MERCADER, *Administrative Patent Judges*.
26

27 APPEARANCES:
28

29 ON BEHALF OF THE APPELLANTS:
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37 The above-entitled matter came on for hearing on Tuesday, January
38 10, 2012, commencing at 9:35 a.m., at the U.S. Patent and Trademark

1 Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,
2 Notary Public.

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4 P R O C E E D I N G S

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6 THE USHER: Good morning. Calendar Number 14, Appeal Number
7 2010-006340, Mr. Sachar.

8 JUDGE MACDONALD: I have several questions and some
9 comments before we begin.

10 You've been here before?

11 MR. SACHAR: Yes.

12 JUDGE MACDONALD: You're aware you have 20 minutes?

13 MR. SACHAR: Yes.

14 JUDGE MACDONALD: We have reviewed the record. We find
15 some of your arguments persuasive, but we have questions about other
16 arguments. We want to focus on those today.

17 MR. SACHAR: Please.

18 JUDGE MACDONALD: We do not need to discuss the 102 and 103
19 rejections.

20 MR. SACHAR: Okay.

21 JUDGE MACDONALD: That's probably the key reason you're here
22 today. But we have concerns about the 101, that's your Subject Matter
23 rejection. Correct me if I'm in error here, the original claims before us,
24 which are 27 through 30, recite a tangible computer readable medium. The
25 original claims, which I'm looking at Claim 12, just recited a medium.

1 Your specification describes the medium, and I thought your
2 specification was very clear as to your intent for that term. You indicate the
3 program can be furnished in a pre-installed state on a hard disk. You
4 indicate several other forms of storage medium.

5 MR. SACHAR: Excuse me, Judge MacDonald, can you please
6 identify the page for me?

7 JUDGE MACDONALD: Page 56, it's near the end of the
8 specification. The last full page of the specification.

9 We have no concerns with respect to those embodiments. That if the
10 claim was limited to those embodiments, it would be statutory. We don't
11 have a problem with that aspect of it.

12 However, you also indicate that the medium could be a radio path,
13 could be through a network so it could be stored later. It says, "so as to be
14 stored in the enclosed hard disk."

15 The key sentence here is the one that concludes this discussion. "The
16 meaning of the medium in the specification is to be construed broadly to
17 comprise all these mediums."

18 So we have both storage mediums and transmission mediums. Even
19 though you don't use those terms, that's what we typically see in the art.
20 That specifications use that terminology, and you certainly have examples of
21 both here.

22 So our question becomes has the guidance from the director which has
23 been published, which is if the claims aren't limited to essentially the first
24 type, then there's a problem.

25 MR. SACHAR: Um-hum.

1 JUDGE MACDONALD: So our sole issue here is: Is the current
2 language of the claim limited to only one of these two? The Examiner has
3 said that it's not, so proceed from there, please.

4 We'll have some questions as we go.

5 MR. SACHAR: I think our position is that by inserting the word
6 tangible we have limited the claims to the tangible mediums such as the hard
7 disk. That was our intent with that claim amendment. I don't have the exact
8 spot, but I believe in our remarks we have commented that although the
9 claim as originally written may have been broad enough to read on both
10 aspects, we've amended them to limit them to the first aspect you talked
11 about the hard disk.

12 That's our intent with the word tangible.

13 JUDGE MACDONALD: I'll express my concern. I don't know that
14 it's quite enough without the word storage in there to indicate it's a storage
15 medium.

16 The reason being I went back and read Nuijten, and they don't use the
17 word tangible by itself. They always say tangible article in that decision,
18 which is the critical one, I think, on this point.

19 To me tangible medium I don't see as being enough given the breadth
20 you establish for the term medium to begin with. We're really into a debate
21 about is a radio path tangible? Is a network tangible even though it doesn't
22 really store the program that's recited in the remainder of the claim?

23 Our view, I think -- for all of us -- is storage requires a physical,
24 tangible article in a way that the Nuijten decision discusses it. Therefore,
25 that's an article of manufacture, no problem.

1 But without that, given everything we have in front of us, it still could
2 be read, I think, as covering —

3 MR. SACHAR: The claims were amended before the most recent
4 guidelines were issued.

5 JUDGE MACDONALD: Yes, that's what --

6 MR. SACHAR: Obviously, our intent is to limit the claims to -- as
7 you said, the specification discloses two different aspects.

8 Reading the claims in light of the specification and in light of the
9 arguments, it seems to us reasonable to say that they could only read on that
10 first --

11 JUDGE MACDONALD: If you're comfortable with that -- if your
12 intent is that it is limited to the storage media, we can so indicate in our
13 decision.

14 MR. SACHAR: That's our intent.

15 JUDGE MACDONALD: That we are comfortable that storage media
16 are statutory and express our concerns. That way, hopefully, the Examiner
17 will permit a quick amendment to take care of that.

18 MR. SACHAR: That is our intent. You know, from our point of
19 view, we would read the word storage into it, but if that has to be added, I
20 don't perceive that to be an issue.

21 That would be consistent with our previous arguments and our
22 disclosure.

23 JUDGE MACDONALD: With these types of claims we prefer to
24 have the language explicitly in the claim.

25 MR. SACHAR: Okay.

1 JUDGE MACDONALD: Do you have any further things you wish to
2 discuss with us?

3 MR. SACHAR: No further issues.

4 JUDGE MACDONALD: Thank you.

5 (Whereupon, the proceedings at 9:43 a.m. were concluded.)
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